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Andrew Tatta

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LAMORTE & ASSOCIATES P.C.
P.O. BOX 434
YARDLEY, PA 19067

EXAMINER

CHAN, KO HUNG

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/691,718
Filing Date: October 22, 2003
Appellant(s): TATTA, ANDREW

MAILED

SEP 19 2007

GROUP 3600

Eric A. LaMorte
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 29, 2007 appealing from the Office action mailed November 2, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Regarding the Kassab reference (US patent no. 6,258,200) in the grounds of rejections items 1 through 6 as labelled by appellant, it is NOT Kassab's invention that is being applied, but rather Kassab's Prior Art discussion in the specification and drawings (figures 1 and 2) .

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,127,938	FRIEDMAN	10-2000
6,258,200	KASSAB (Prior Art fig. 1-2)	7-2001
5,688,579	KONSTI ET AL	11-1997
4,848,542	BURNETTE ET AL	7-1989
5,152,593	DOMENIG	10-1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1, 3, 8, 9, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (US patent no. 6,127,938) in view of Prior Art as disclosed by Kassab (6,258,200). Friedman discloses a mounting device (14) for mounting an electronic toll having a flexible substrate (14, figure 5) mounted to windshield and hook-and-loop fastener means for attaching the electronic toll wherein the substrate inherently diminishes the visibility of the electronic toll pass through the windshield. However, Friedman does not specifically disclose that the substrate (14) is mounted via adhesive to the windshield but it is well-known in the art that substrate is

mounted via adhesive. Friedman does not show a display image on the substrate. To provide a display image on substrate such the image display is directly attached to the windshield are old and well-known. Kassab teaches that in prior art device of providing a flexible substrate having adhesive layer (18, figure 2) over a printed display image (indicia) to be mounted onto a windshield for displaying various information (col. 1, lines 26-30). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to have provided display image to the substrate of Friedman such that information can be displayed through the windshield and to adhesively attach the substrate as taught by the Prior Art disclosed by Kassab. Appellant's method steps would have been obvious given the device of Friedman and Kassab combined.

Claims 2, 6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (US patent no. 6,127,938) in view of Prior Art as disclosed by Kassab (6,258,200) as applied to claims 1 and 9 above, and further in view of Konsti et al (US patent no. 5,688,579). Friedman and Kassab combined disclosed all the claimed features of appellant's invention except for the material of the substrate as being opaque and of paperboard material. Konsti et al teaches that it is old and well-known to make a mounting composite or substrate (72) of opaque material such as paperboard having adhesive on rear surface (74) and hook fastener (82) on the other side. It would have been obvious to one of ordinary skilled in the art to have make the substrate of Friedman and Kassab combined such that it is of opaque and of paperboard material as taught by Konsti as such material for mounting substrates are old and well-known.

Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (US patent no. 6,127,938) in view of Prior Art as disclosed by Kassab (6,258,200) and Konsti et al (US patent no. 5,688,579) as applied to claims 1, 6, 9, and 11 above, and further in view of Burnette (US patent no. 4,848,542). Friedman and Kassab, and Konsti et al combined disclosed all the claimed features of appellant's invention except for the face surface is laminated. Burnette teaches a mounting device (Fig. 2A) including a display image (at 22 generally) printed, adhered, or laminated to its surface (col. 4, lines 25-31). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have laminated the display image to the substrate of Friedman and Kassab and Konsti combined as an alternative to printing as taught by Burnette.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (US patent no. 6,127,938) in view of Prior Art as disclosed by Kassab (6,258,200) as applied to claim 1 above, and further in view of Burnette (US patent no. 4,848,542). Friedman and Kassab combined disclosed all the claimed features of appellant's invention except for the image is adhere to the face surface. Burnette teaches a mounting device (Fig. 2A) including a display image (at 22 generally) printed, adhered, or laminated to its surface (col. 4, lines 25-31). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have adhered the display image to the substrate of Friedman and Kassab combined as an alternative to printing as taught by Burnette.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (US patent no. 6,127,938) in view of Prior Art as disclosed by Kassab (6,258,200) as applied to claim 9 above, and further in view of Domenig (US patent no. 5,152,593). Friedman and Kassab combined disclosed all the claimed features of appellant's invention except for the adhesive as being double sided adhesive. Domenig teaches a substrate (44) with hook fastener at one end (26) mounted to a wall surface via double adhesive tape (col. 4, lines 23-26). It would have been obvious to one of ordinary skilled in the art to have use a double adhesive tape type of adhesive for mounting the substrate of Friedman and Prior Art of Kassab combined onto the windshield as such adhesive means are old and well-known as taught by Domenig.

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(10) Response to Argument

Ground 1. Regarding the rejection of claims 1, 3, 8, 9, 13, and 15 under 35 USC 103(a) as being unpatentable over Friedman'938 in view of Kassab'200, appellant argues that primary reference of Friedman teaches away from appellant's invention for the reason that Friedman demonstrates additional structures of the housing member 22 that is not a flexible support substrate nor the housing shields signal from the transponder are off the point.

A reading of appellant's claims 1, 3, 8, and 9 rejected under this section indicates that only the mounting strip or flexible substrate of appellant's device is being claimed.

In the rejection, Friedman demonstrated the flexible substrate (14 best seen in figure 5, Friedman) which is a flexible substrate with one side mounted directly to the windshield (W, figure 3) and the opposite side Velcro on the other to support the toll pass assembly. Friedman does not disclose that his strip (14, figure 5) is mounted via adhesive nor a display image covering one side of the substrate. The Prior Art disclosed in Kassab teaches mounting of substrate to a windshield via adhesive (18, figure 2) with a display image thereon. Such use of adhesive for mounting strip to the windshield is conventional and well-known. It is so conventional and well-known that the primary reference of Friedman may have not bother to mention how his flexible substrate 14 is mounted to the windshield. Nevertheless, Kassab discussed that Prior Art demonstrates that such adhesive for mounting substrate to a windshield is old and conventional. Regarding appellant's display image covering the face surface, examiner has reservation whether such recitation "display image" might already be seen in Friedman. Indeed, reasonable interpretation of such "display image" would include anything visual on the strip 14 of Friedman. However, for the sake of argument, even Kassab's discussion of Prior Art demonstrates display image on a substrate. Additionally, Furthermore regarding appellant's display image provided on the flexible substrate, the printed matter on the flexible substrate is not functionally related to the substrate. The flexible substrate would function to hold the toll pass as well as reduce visibility regardless of whether the flexible substrate has indicia or not. "Where the

printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability". *In re Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004)

Further, the argument that the secondary reference Kassab makes no disclosure concerning holding of a toll pass is also off the point. As discussed above, Kassab's Prior Art discussion discloses that adhesive layer (18, figure 2) are conventionally used to directly mount flexible substrates to windshields.

The combination of Friedman and Kassab's Prior Art discussion would have yielded a flexible substrate with display image and adhesive mounted directed on the windshield with the hook-and-loop fastener on the other side for mounting a toll pass as claimed in claims 1, 3, 8, 9, 13, and 15. The method steps of claim 9 would have been obvious given the structure of Friedman and Kassab's Prior Art discussion combined.

Ground 2. Regarding the rejection of claims 2, 6, and 11 under 35 USC 103(a) as being unpatentable over Friedman'938 in view of Kassab's Prior Art disclosure and further in view of Konsti, appellant argues that Konsti is not concerning with mounting a toll pass but rather mounting paperboard material to a vertical wall. Examiner would like to point out that claims 2, 6, and 11 are directed to substrate material of opaque and paperboard material. Konsti is used to demonstrate and teach that such substrate materials are old and well-known surface mounting materials. One of ordinary skill would have known the availability of such material for surface mounting as

demonstrated by Konsti. To modify the toll pass holder substrate of Friedman and Kassab's Prior Art combination would have been obvious.

Ground 3, regarding the rejections of claims 7 and 12 under 35 USC 103(a) as being unpatentable over Friedman'938 in view of Kassab's Prior Art disclosure and further in view of Konsti'579 and Burnette'542, appellant brings the limitation of lamination of the face surface of the substrate which Burnette'542 teaches. Appellant does not argue the fact Burnette does teach lamination of a display image (22, figure 2A and col. 4, lines 25-31, Burnette). Appellant merely refers back to the combination rejection of Friedman, Kassab's Prior Art, and Konsti of not providing a flexible substrate for mounting a toll pass which as discussed by the examiner is demonstrated by Friedman, Kassab's Prior Art, and Konsti combined as presented above.

Ground 4, regarding the rejection of claim 4 under 35 USC 103(a) as being unpatentable over Friedman'938 in view of Kassab's Prior Art disclosure and further in view of Burnette, appellant does not provide any argument there against.

Ground 5, regarding the rejections of claim 14 under 35 USC 103(a) as being unpatentable over Friedman'938 in view of Kassab's Prior Art disclosure and further in view of Domenig, appellant brings in the limitation in claim 14 of using double-sided tape to mount the substrate to the windshield. Such double-sided adhesive are old and well-known as demonstrated by Domenig'593. To substitute the adhesive used in Friedman and Kassab's Prior Art combination with double-sided adhesive would have been obvious to one of ordinary skill in the art as it is old and well-known. Appellant's argument Domenig does not make reference to electronic toll pass windshield is not

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persuasive. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have the knowledge of the availability of the adhesives that is of the double-sided tape as demonstrated by Domenig.

Ground 6. In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the cases above, the knowledge is generally available to one of ordinary skill in the art as demonstrated above.

Furthermore regarding appellant's display image provided on the flexible substrate, the printed matter on the flexible substrate is not functionally related to the substrate. The flexible substrate would function to hold the toll pass as well as reduce visibility regardless of whether the flexible substrate has indicia or not. "Where the printed matter is not functionally related to the substrate, the printed matter will not

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distinguish the invention from the prior art in terms of patentability". *In re Ngai*, 70

USPQ2d 1862 (Fed. Cir. 2004)

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Korie H. Chan/
Korie H. Chan
Primary Examiner
Art Unit 3632

Conferees:

Carl Friedman



Meredith Petravick

